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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ALOMARI, FIRAS B

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,019

Applicant(s)

TOH ET AL.

Examiner

Firas Alomari

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02/25/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-57 are rejected.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-16, 21-36, 40-51 and 53-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Everingham US (6,327,611) in view of Kara US (5,982,506).

As per claim 1,29 and 45: Everingham discloses a method for delivering a document from a sender to a next recipient on a routing list comprising the steps of:

Receiving an indication that the sender desires to deliver a document to a next stage on a routing list for the document;(Col 5,lines 31-36) and

Identifying a recipient from the next stage on the routing list;(Col 5, Line 34-36)

but Everingham doesn't show the step of providing a key selected from a group of the recipients public keys and an escrow encryption key. However Kara discloses a system for certifying electronic documents where he teaches

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providing a public message key associated with the recipients of the document (Col4, Lines 7-40) and a private message key (Col5, Lines 23-26) and (Figure 3b, item 3103-3104). Therefore it would have been obvious to one ordinary skilled in the art at the time the invention was made to modify Everingham system with the teachings of Kara to include providing key from recipients public keys and an escrow encryption key. One would be motivated to do so in order to enable the system to provide verification mechanisms to protect against modification and to provide high degree certainty of the content and source and authenticity of the message.

As per claim 2: Everingham discloses the method of claim 1 further comprising defining and storing the routing list before an originating sender indicates a desire to deliver the document to the routing list (Col 4, Lines 12-19)

As per claim 3: Everingham discloses the method of claim 1 further comprising receiving the routing list and an indication that the user desires to deliver the document to the list and storing the routing list (Col 5, Lines 31-42)

As per claim 4,30 and 46: Everingham discloses a system a document routing system receiving routing list and an indication to send the document to the next stage at the routing list but doesn't explicitly disclose the method of claim 1 further comprising sending the key to the sender. However Kara discloses a method for securing a document in a document delivery system where he

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teaches sending a key to the sender (FIG. 3B item 3103 and Col 4, lines 37-39).

Therefore it would have been obvious to one ordinary skilled in the art at the time the invention was made to modify Everingham system with the teaching of Kara to include sending the key to the sender to enable the sender to send the message. One is motivated to do so in order to enable Everingham system to encrypt the document using the recipient public key before sending it and enables the sender to verify other persons other than the intended recipients will not read the document.

As per claim 5: Everingham doesn't disclose the method of claim 4 comprising sending a digital certificate containing the recipient's public key. However Kara discloses a system for certifying document delivery where the system includes the step of sending a digital certificate to the sender containing the recipient public key (Col 6, lines 54-60 and item 3003 of FIG. 3A). therefore it would been obvious to ordinary skilled in he art at the time the invention was made to modify Everingham system with the teaching of Kara to include the step of sending a digital certificate containing the recipient public key. One would be motivated to do so in order to enable the sender to encrypt the message using the public key of the certificate with a high degree of certainty about the recipient's identity.

As per claim 6: Everingham doesn't discloses the method of claim 4 further comprising encrypting the document using the key and the sender delivering the encrypted document to the recipient. However Kara discloses a system for

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securing document delivery where the sender encrypts the document using the key (Col 6, Lines 62-64) and the sender delivering the encrypted document to the recipient (Col 7, Lines 40-44). Therefore it would be obvious to one ordinary skilled in the art at the time the invention was made to modify Everingham system with the teaching of Kara to allow the sender to encrypt the document using the key and delivering the decrypted document to the recipient afterward. One would be motivated to do so in order to enable the system to provide a mechanism for determining the time of a transmission, proving the source and destination of a transmission and authenticating the content of the transmission.

As per claim 7: Everingham discloses the method of claim 1 further comprising the sender delivering the document to the recipient. (Col 5, Lines 43-47)

As per claim 8: Everingham discloses the method of claim 1 wherein the routing list is identified by a routing list identifier; and the step of receiving an indication that the sender desires to deliver a document to a next stage on the routing list includes receiving the routing list identifier (Col 5 , Lines 33-39).

As per claim 9: Everingham discloses the method of claim 8 wherein the routing list identifier includes an email address. (Col 4, lines 1-11)

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As per claim 10: Everingham discloses the method of claim 8 wherein the routing list identifier an address at a domain name for routing lists.(Col 4, lines 1-11)

As per claim 11: Everingham discloses the method of claim wherein the next stage in the routing list comprises a group of recipients; and the step of identifying a recipient from the next stage comprises identifying at least one of the recipients group. (Col 6, Lines 57-64)

As per claim 12,32 and 49: Everingham discloses the method of claim 1 wherein the step of receiving an indication that the sender desires to deliver a document to a next stage on the routing list comprises:

Receiving a query from the sender for an identity of a recipient from the next stage on the routing list. (Col 6, Lines 57-64)

As per claim 13: Everingham discloses the method of claim 12 further comprising:

Tracking a current recipient of the document from the routing list; and in response to the query; (Col 4, Lines 34-40)

Returning an error message, if the routing list cannot be located or the querying sender is not the current recipient; and (Col 4, Lines 40-55)

Returning the identity of at least one recipient from the next stage of the routing list, if the querying sender is the current recipient. (Col 5, Lines 43-47)

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As per claims 14,34 and 50: Everingham discloses the method of claim 1 further comprising tracking a current recipient of the document from the routing list. (Col 5 line 66 through Col 6 line 7)

As per claim 15: Everingham discloses the method of claim 14 further comprising receiving confirmation that the recipient has received the document; and updating the current recipient of the document to reflect the received confirmation. (Col 5 line 45 and Col 5 line 66 through Col 6 line 7)

As per claims 16,35 and 51: Everingham discloses the method of claim 1 wherein the routing list includes rules. (Col 3, Lines 62-63)

As per claims 21,41 and 54: Everingham discloses the method of claim 1 wherein the step of receiving an indication that a sender desires to deliver a document to the next stage on a routing list comprises receiving a form containing rules for the routing list. (Col 4, Lines 12-30 and Col 5, Lines 43-60 / the control portion contain rules information along with the routing list)

As per claims 22,42 and 55: Everingham discloses the method of claim 1 wherein the step of receiving an indication that the sender desires to deliver a document to a next stage on a routing list comprises receiving a routing parameter for the routing list. (Col 5, Lines 33-39).

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As per claims 23,40 and 53: Everingham discloses the method of claim 1 wherein the step of receiving an indication that a sender desires to deliver a document to a next stage on a routing list for the document comprises receiving the document along with an indication. (Col 5, Lines 31-42)

As per claim 24: Everingham discloses the method of claim 23 further comprising delivering the document to the recipient. (Col 5, Lines 43-47)

As per claim 25: Everingham discloses the method of claim 23 further comprising delivering the document in read-only mode to the recipient. (Col 6, Lines 22-27)

As per claim 26: Everingham doesn't disclose the method of claim 23 further comprising encrypting the document using the key before delivering the encrypted document to the recipient. However Kara discloses a system for securing document delivery where the sender encrypts the document using the key (Col 6, Lines 62-64) and the sender delivering the encrypted document to the recipient (Col 7, Lines 40-44). Therefore it would be obvious to one ordinary skilled in the art at the time the invention was made to modify Everingham system with the teaching of Kara to allow the sender to encrypt the document using the key and delivering the decrypted document to the recipient afterward. One would be motivated to do so in order to enable the system to provide a mechanism for determining the time of a transmission, proving the source and

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destination of a transmission, authenticating and protecting the content of the transmission.

As per claims 27,43 and 56: Everingham doesn't disclose the method of claim 1 further comprising authenticating the sender's public key, establishing a secure connection with the sender and receiving the document from the sender via the first secure connection. However Kara discloses a system for securing document delivery where the system authenticates the sender using the sender public key, in conjunction with the sender using the sender private key to authenticate the sender, where the public key is used to generate an encryption of the document and associated cipher. (Column 4, lines 37-51) and where the private is needed to decrypt the document for verification purposes, (Column 6, line 60) - (Column 6, line 5), and this verification is performed by the certification system. (Column 9, lines 42-48), establish a secure connection with the sender (FIG. 3 Items 3014-3016) and receives the document from the sender via the first secure connection (FIG. 3B item 3110). Therefore it would be obvious to one ordinary skilled in the art at the time the invention was made to modify Everingham system with the teaching of Kara to allow the system to authenticate the sender's key, establish a secure connection and receive the document. One would be motivated to do so in order to enable the system to provide a mechanism for determining the time of a transmission, proving the source and destination of a transmission, authenticating and protecting the content of the transmission.

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As per claims 28,44 and 57: Everingham doesn't disclose the method of claim 27 further comprising authenticating the recipient using recipient's public key, establishing a secure connection with the recipient and transmitting the document from the sender via the first secure connection. However Kara discloses a system for securing document delivery where the system authenticates the recipient's using the recipient public key, in conjunction with the recipient using the recipient private key, to authenticate the recipient, where the recipient public key and private key is the same key established by the certification system for the sender, and is used by the certification system to authenticate the recipient. (Column 5, lines 1-15), Establishing a second secure connection with recipient. (Figure 3b, Item 3109), and transmitting the document to the recipient via the second connection (Figure 3b, item 3116). Therefore it would be obvious to one ordinary skilled in the art at the time the invention was made to modify Everingham system with the teaching of Kara to allow the system to authenticate the recipient's using the recipient key, establish a secure connection and receive the document. One would be motivated to do so in order to enable the system to provide a mechanism for determining the time of a transmission, proving the source and destination of a transmission, authenticating and protecting the content of the delivery.

As per claims 31 and 47: Everingham discloses the computer program product of claim 29 wherein the routing list is identified by an email address;(Col 4, lines 1-

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11) and the step of receiving an indication includes receiving the email address.

(Col 5, Lines 33-39)

As per claims 32 and 48: Everingham discloses the computer product program of claim 29 wherein the routing list is identified by an address at a domain name for routing lists;(Col 4, lines 1-11) and the step of receiving an indication includes receiving the address. (Col 5, Lines 33-39)

3. Claims 17-20, 36-39 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Everingham US (6,327,611) in view of Kara US (5,982,506) as applied to claims 1-16 above, and further in view of Geiger et al. US (6,073,142).

As per claims 17,36 and 52: Everingham discloses some rules being applied to the routed document and the routing list but the combination of Everingham and Kara doesn't show the rules encapsulated in forms. However Geiger discloses a system for document routing in a networked environment where the document reviewing rules are encapsulated into a form (Col 15, lines 55-67 and FIG. 8). Therefore it would be obvious to one ordinary skilled in the art at the time the invention was made to modify Everingham and Kara system with the teachings of Geiger to encapsulate the rules into a form for the rules engine. One would be motivated to do so in order to enable the system to provide the ability to define business rules and distribution control over various types of data objects.

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As per claims 18 and 37: Everingham discloses some rules being applied to the routed document and the routing list but the combination of Everingham and Kara doesn't show the rules embodying business processes. However Geiger discloses a system for document routing in a networked environment where the document reviewing rules are embodied in a business process (Col 12, Lines 53-66 and Col 13, Lines 15-25). Therefore it would be obvious to one ordinary skilled in the art at the time the invention was made to modify Everingham and Kara system with the teachings of Geiger to embody a business process into the rules. One would be motivated to do so in order to enable the system to provide the ability to define business rules and to control distribution over various types of data objects in light of business communication policy (Col 3, Lines 1-20).

As per claims 19 and 38: Everingham discloses the routing list as being an ordered group of email addresses recipients but the combination of Everingham and Kara doesn't show the routing list including a conditional recipients. However Geiger discloses a system for document routing in a networked environment where the document the routing list includes a conditional recipient (Col 22, Lines 48-57). Therefore it would be obvious to one ordinary skilled in the art at the time the invention was made to modify Everingham and Kara system with the teachings of Geiger to include a conditional recipients in the routing list. One would be motivated to do so in order to enable the system to provide review of messages according to the message proprieties and content and to control

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distribution over various types of data objects in light of business communication policy (Col 3, Lines 1-20).

As per claims 20 and 39: the combination of Everingham and Kara doesn't show the step of receiving an indication that the sender desires to deliver the document comprising receiving a parameter from the sender, wherein the recipient depends on the parameter received. However Geiger discloses a system for document routing in a networked environment where the document the routing list includes a conditional recipient (Col 10, Lines 54-62). Therefore it would be obvious to one ordinary skilled in the art at the time the invention was made to modify Everingham and Kara system with the teachings of Geiger to include a conditional recipients in the routing list. One would be motivated to do so in order to enable the system to provide review of messages according to the message proprieties and content and to control distribution over various types of data objects in light of business communication policy (Col 3, Lines 1-20).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firas Alomari whose telephone number is (571) 272-7963. The examiner can normally be reached on M-F from 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, AYAZ SHEIKH can be reached on (571) 272-3795. The

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fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Firas Alomari
Examiner
Art Unit 2136

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